

Application No.: 09/944,887

Docket No.: IA00009

REMARKS

Claims 1-18 remain pending in the application. The Office action asserts the claims do not meet the requirements of patentability under 35 U.S.C. §103(a) as being unpatentable over Civanlar et al. (EP 0 884 873) in view of Razavi et al. (WO 00/77620). Applicants traverse this contention and request reconsideration.

The applicants responded to the January 14, 2004 Office action arguing the patentability of the pending claims at least because there is no suggestion or motivation in either Civanlar et al. or Razavi et al. to combine the references and arrive at the claimed invention. In reasserting the rejection, the examiner acknowledges the duty to supply the requisite factual basis but again fails to provide a sufficient factual basis for the rejection.

The examiner responds to the applicants' argument acknowledging that the structure taught by Civanlar et al. "is not implemented in a vehicle." The examiner then recites a number of characteristics of the structure taught in Razavi et al., which is implemented in a vehicle. After reciting these characteristics of Razavi et al., the examiner then concludes "it would have been obvious to one having ordinary skill in the art to use the communication system of Civanlar et al. in a vehicle as taught by Razavi for the purpose based on design/environment choice specific to the system requirement." There is simply no support for this conclusion that can be drawn from the references themselves, and the examiner makes no citation to the references that suggest or motivate the combination. There is no teaching or suggestion in the references that the network structure taught by Civanlar et al. would adequately function within a vehicle environment or even that it could be so adapted. The only suggestion to combine an active network architecture in a vehicle is the applicants' own disclosure, which is an improper hindsight basis for rejecting the claims for obviousness. As noted by the applicants in their prior response, the examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967); MPEP 2142.

The examiner has put forward no factual basis for concluding that one of ordinary skill in the art would be motivated to combine Civanlar et al. with Razavi et al. to

100

Application No.: 09/944,887

Docket No.: IA00009

achieve the claimed invention. As such, the examiner has failed to establish a prima facie case of obviousness, and claims 1-18 are allowable.

The final Office action fails to address the applicants' second contention as to why the combination of Civanlar et al. and Razavi et al. fails to render the pending claims unpatentable. To establish a prima facie case of obviousness, and hence to find claims 1-18 unpatentable under 35 U.S.C. § 103(a), among the three basic criteria that must be met the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP at § 2142. The combination of Civanlar et al. and Razavi et al. also fails to establish a prima facie case of obviousness because the proffered combination fails to teach or suggest each and every limitation of the claims. The claims set out, among other things, that a device disposed within the vehicle and having a vehicle related function forms a portion the active network.

As established by the applicants in their response to the August 12, 2003 Office action, an active network is a network in which nodes perform custom operations on the messages that pass through the nodes. See Reinold Declaration, paragraph 8 attached therewith. Thus, for a device to form part of the active network, the device must allow messages to pass through while at the same time be capable of performing custom operations on the messages as they pass through. Further, in accordance with the claim, the device must have a vehicle related function. Civanlar et al. fails to teach or suggest any such structure or functionality.

In response, the examiner merely reasserts that the device 90 forms a portion of the active network without answering the applicants' argument to the contrary. It is clear the device 90 of Civanlar et al. is not part of the described packet network. Again, the applicants traverse that the network structure taught by Civanlar et al. is an active network, but in the context of the instant claims it is unnecessary because even if Civanlar et al. do teach an active network it does not teach the device 90 being part of an active network. It is clear the packet network that is taught by Civanlar et al. consists of IP relay routers 110-115 forming the "edge" of the network and IP relay switches 120-123 forming the "core" of the network to provide connectivity of local area networks (LANs) 100-105. The device 90 is not only outside the "network" defined by Civanlar et al. as the core and edge components, it

Application No.: 09/944,887

Docket No.: LA00009

connected through the LAN 100. In fact, the device 90 is characterized as a source host device, such as personal computer, that sends IP packets via the LAN 100. There is no teaching or suggestion that IP packets are routed through the device 90 or that the device 90 can perform custom operations on the IP packets, both of which are required for the device 90 to be considered a part of an active network.

Moreover, as acknowledged by the examiner, Civanlar et al. is not addressed to a vehicle application. Therefore, there is simply no way the device 90 could be device having a vehicle related function. There is no disclosure whatsoever in Civanlar et al. of a vehicle or how the device would perform a vehicle related function.

Thus, for at least a second reason the combination of Civanlar and Rozavi et al. fails to establish a prima facie case of obviousness because the combination fails to teach each and every limitation of the claims.

For at least the foregoing reasons the applicants submit claims 1-18 are allowable, and such action is respectfully requested.

If there are any additional fees or refunds required, the Commissioner is directed to charge or debit Deposit Account No. 13-2855.

Dated: November 12, 2004

Respectfully submitted,

By 

Anthony G. Sitko

Registration No.: 36,278

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant